

gub
E5
a b
coupling capacitor has a substantially smaller capacitance than said second coupling capacitor.

36. (New Claim) The cardiac pacing system as recited in claim 34, wherein said second coupling capacitor has a capacitance ranging from 10-40 microfarads, and said first coupling capacitor has a capacitance less than 5 microfarads.

REMARKS

Applicant wishes to thank the Examiner for the thorough examination of the subject application. The office action rejects claims 1-18 under 35 U.S.C. §112 second paragraph as being indefinite based on a conclusion that claim limitations have been inferentially included rather than positively recited. The amendment to the claims overcomes this rejection and a notice to that affect is respectfully requested. The office action rejects claims 1, 2, 16-18 under 35 USC 102(e) as being anticipated by Zhu et al (5843136). The claims as amended are no longer anticipated or obvious from the Zhu et al. disclosure. The office action rejects claims 1, 2, 16-18 under 35 USC 102(f) asserting "the applicant did not invent the claimed subject matter". The named inventors are believed to be the true and correct inventors of the invention as claimed in the amended claims.

The office action has rejected claims 1, 2, 4, and 8-15 under 35 U.S.C. 102(b) as being anticipated by Silvian (4,991,583). Silvian does not show or describe the claimed invention. Without limitation, the attenuation means or coupling capacitors ^{or} having reduced capacitance is not shown or described by Silvian. Therefore, does not anticipate the claimed invention.

The office action further rejects claims 1, 2, 4, 8-15 under 35 USC 103(a) as obvious over Silvian, rejects claims 3 and 5-7 under 35 USC 103(a) as being unpatentable over Silvian, rejects

claims 3-15 under 35 USC 103(a) as being unpatentable over Zhu et al. and rejects claims 1-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Zhu et al. Each of these rejections is based on an unsupported conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify or incorporate the device described by Silvian or Zhu et al. into a device as claimed by the present invention. For the reasons given below, the rejection in its entirety is respectfully traversed. The claims have been amended to further clarify the claimed invention. Without limitation, none of references relied on in the office action show or describe the claimed pacing system including multiple leads, electrodes, pacing circuit, sensing circuit including a switch corresponding to each electrode, and attenuating means.

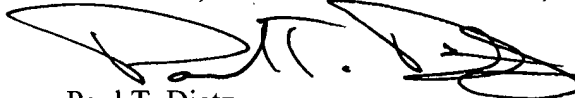
The office action contends that “it would have been obvious to a person of ordinary skill in the art to sense evoked responses between a ventricular electrode and an atrial electrode.” The claimed sensing between the electrodes using the claimed device is not described in Silvian or Zhu et al. nor do Silvian or Zhu et al. suggest such a combination.

When a claimed element is absent from the teachings of a reference, there must be a suggestion to combine the teachings of other relied upon references. The mere fact that references might be able to be combined or modified in a manner suggested, does not render the resultant combination obvious unless the references also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990). It appears that hindsight has been used to reconstruct the claimed invention from the cited references. “It is impermissible however, simply to engage in a hindsight reconstruction of the claimed invention,

using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 18 USPQ.2d 1885 (Fed. Cir. 1991). Each of the claims include limitations that are not shown or described by the cited references. Further, a prima facie case of obviousness can only be established by combining or modifying the teachings of the cited references to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992); (see MPEP 2143.01).

This suggestion or teaching is absent in the references relied on in the office action. Thus, claims 1-18 are believed to be in a condition of allowance and a notice to that affect is respectfully requested. Further, new claims 19-36 includes limitations that are neither shown or described in the Silvian nor the Zhu et al. reference. Hence, new claims 19-36 are also believed to be in a condition of allowance and a notice to that affect is respectfully requested. The amendments and remarks set forth above are provided to expedite and advance the prosecution of the patent application.

Respectfully submitted,
NIKOLAI, MERSEREAU & DIETZ, P.A.



Paul T. Dietz
Registration No. 38,858
820 International Centre
900 Second Avenue So.
Minneapolis, MN 55402
(612) 339-7461